

Appl. No. 09/806,197

Request for Clarification and Withdrawal of PTO paper dated December 27, 2004

### REMARKS

Applicants respectfully submit that their Amendment of September 24, 2004 should be entered, the PTO PAIR system corrected, and the attorney docket reference updated to 7372/70911.

Applicants' counsel respectfully requests the PTO to withdraw the PTO written communication bearing "date mailed: 12/27/2004" to which was attached a two-page document having a sub-heading "paper" above 112004.<sup>1</sup> A copy is attached as Exhibit A for the Examiner's reference. The handwritten application number at the second page of Exhibit 2 appears on the original copy as received from the PTO today, December 29, 2004. This paper appears mistaken in several regards:

- a. This PTO paper states "[t]he amendment to the claims filed on 8/31/04 does not comply with the requirements of 37 CFR 1.121(c) because there are changes in claim 1 which have not been underlined."

■ There was NO amendment to the claims filed in U.S. Appln. No. 09/806,197 on "8/31/04."

- b. The PTO paper states "[f]or example, the work [sic] "bacterial" has been added in lines 1, 2, and 4 without underlining..."

■ The word "bacterial" does NOT appear in Applicants' claim 1 as amended on September 24, 2004:

Claim 1 (currently amended): ~~A~~ An isolated promoter comprising the following DNA (a) or (b), characterized in that it is capable of functioning in plant cells:

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<sup>1</sup> Clarification as to what the paper pertains is also respectfully solicited.

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(a) DNA comprising the nucleotide sequence shown in SEQ ID No. ~~1~~ NO:1, or

(b) DNA comprising

a nucleotide sequence in which one or more bases are deleted, substituted, or added in the nucleotide sequence shown in SEQ ID No. ~~1~~ NO:1, and which has more than 90% identity to the nucleotide sequence of any region consisting of 250 bp or more within the nucleotide sequence shown in SEQ ID No. ~~1~~ NO:1, which contains the nucleotide sequence shown in SEQ ID No. ~~24~~ NO:24, and which hybridizes to the nucleotide sequence shown in SEQ ID NO:1 under conditions that include washing in 300 mM sodium chloride, 30 mM sodium citrate, and 1% SDS at 55°C, wherein said DNA has promoter functions equivalent to those of the above DNA (a).

c. The PTO paper states "... the words "to be changed" and "the method comprising" has been added to line 5..."

■ The words "to be changed" and "the method comprising" do NOT appear in amended claim 1 as presented herein on September 24, 2004.

d. The PTO paper states "'wherein a'" has been deleted from original line 6 and 'introducing the' has been added to line 6; etc."

■ The words "wherein a" was NOT deleted from original claim 1, line 6, and the claim as amended on September 24, 2004 was presented in a good faith, bona fide effort to advance prosecution herein.

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- The words 'introducing the' have NOT been added to original claim 1 at line 6, and the claim as amended on September 24, 2004 was presented in a good faith, bona fide effort to advance prosecution herein.

To assist the Examiner herein, the APPENDIX hereto lists the claims as presented in the Amendment of September 24, 2004. As stated above, these Amended claims were presented in a good faith, bona fide effort to advance prosecution.

Applicants and their legal representative appreciate the need for an accurate record and properly presented claims so that the Examiner can exercise her judgment on whether Applicants are entitled to a patent grant.

Accordingly, if by chance a clerical oversight was overlooked in the September 24, 2004 Amendment, please do telephone Applicants' legal representative so that all matters can be resolved promptly so that the Examiner has a full and fair opportunity to consider the claims presented for her consideration.

Applicants counsel did telephone the Examiner on December 29, 2004 and left a voice mail message regarding the PTO paper herein dated 12/27/2004.

This Response, including the Appendix, plus Exhibit A constitute 11 pages have been filed by facsimile to 703-872-9306 and to the Examiner's unofficial facsimile 571-273-0780 this 29<sup>th</sup> day of December 2004.

Applicants earnestly, but respectfully, request that the PTO paper dated 12/27/2004 be withdrawn and this application receive favorable action on the merits.

Respectfully submitted,

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